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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,616	08/10/2001	Eric W. Triplett	960296.97273	5346

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EXAMINER

HELMER, GEORGIA L

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 07/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/927,616	Applicant(s) TRIPLETT ET AL.	
	Examiner Georgia L. Helmer	Art Unit 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-10, 12, 13, 15-19, 21, 22 and 24-32 is/are pending in the application.
- 4a) Of the above claim(s) 28-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-10, 12, 13, 15-19, 21, 22 and 24-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>February 2005</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |



DETAILED ACTION

Request for Continued Examination

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 15 November 2004 has been entered.

Status of the Claims

2. Claims 1-4, 6-10, 12-13, 15-19, 21, 22, and 24-32 are pending. Claims 1-4, 6-10, 12-13, 15-19, 21, 22, and 24-27 are examined in the instant action (see below). Claims 28-32 are withdrawn as being drawn to a nonelected invention. Claims 5, 11, 14, 20 and 23 have been canceled.

Election/Restrictions

3. Claims 28-32 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Invention I (claims 1-4, 6-10, 12-13, 15-19, 21, 22, and 24-27) is drawn to a biocontrol method comprising genetically engineered Rhizobiaceae bacteria and bacterial biocontrol agents, class 424, subclass 93.2, for example, and invention II (claims 28-32) a biocontrol method comprising native Rhizobiaceae bacteria, class 424, subclass 93.1, for example.

Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or

different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have operation, different functions, or different effects. The starting materials, methods used for the group II invention do not require the materials and methods of the Group I invention.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, Group I claims (claims 1-4, 6-10, 12-13, 15-19, 21, 22, and 24-27)) are examined in the instant action and Group II claims (28-32) are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

4. The § 1.132 Declaration of Eric Triplett, dated 11 November 2004, is acknowledged.

5. All rejections not addressed below have been withdrawn.

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112 second paragraph

7. Claims 12 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 is rejected as being dependent on a canceled claim.

Correction/clarification is required.

Claim Rejections - 35 USC § 112, first paragraph-Enablement

8. Claims 1-4, 6-10, 12-13, 15-19, 21, 22, and 24-27 are rejected under 35 U.S.C. 112, first paragraph. This rejection is made for the reasons of record as set forth on pages 6-9 in the Office Action mailed 18 February 2004. Applicant's arguments filed 15 November 2004 have been fully considered, but are not deemed persuasive.

Applicant has submitted a Rule 1.132 Declaration from Eric Triplett, an inventor of this application. This Declaration presents data that trifolitoxin-producing bacteria are able to prevent crown gall on grapes (Declaration. p. 2). The Declaration asserts (Response, p. 6) that since the claims have been limited to plant species that are susceptible to crown gall disease, the scope of the claims are not overly broad. Applicant further traverses that the Applicant has shown that the invention method is application to all plants..and that the Applicant should not be limited to using the method on only grape, fruit trees and rose plants (Response, p. 15 November 2004). Applicant's traversal is unpersuasive. Applicant's data (p. 2 Declaration) demonstrates biocontrol of Agrobacterium on grape and of Rhizobium on grape. Applicant has presented biocontrol only on plant hosts Nicotiana and Grape for Agrobacterium strains specific for these plants, and only on grape for Rhizobium. The Declaration gives no evidence on hosts plants other than Nicotiana and Grape, or for other strains of Agrobacterium not adapted to particular plant host species, though Dr. Triplett offers his opinion (Declaration p. 2) that "the efficacy of the methods of the invention goes well beyond simply Nicotiana glauca to any plant species susceptible to crown gall disease".

See *Voisnet v. Coglianese and McCorkle*, 173 USPQ 16 (CCPA 1972), which teaches that the opinion testimony of an expert witness does not establish any material fact and may be rejected in favor of other evidence.

Furthermore, claims 1 and 6-9 are not even limited to particular bacterial genera, and none of the claims are limited to plant hosts combined with their corresponding infective *Agrobacterium* strains.

Claim Rejections - 35 USC § 102

9. Claims 1, 7, 9, 10, 16, 18, and 26 remain rejected under 35 U.S.C. 102(b) as being anticipated by Robleto, et. al. *Environmental Microbiology*, 1998, Vol 64, No. 7, page 2630-2633 (Applicant's IDS).

Robleto et. al. teach a method of controlling crown gall on plants, comprising introducing on to the plant an effective amount of biologically pure culture of an α -proteobacteria, where the α -proteobacteria is *Rhizobium*, that produces trifolitoxin (Table 1 and 1st full ¶, page 2631; and Table 3, page 2632), where the α -proteobacteria is engineered to express the trifolitoxin operon, where the α -proteobacteria is engineered to express a pT2TFXK plasmid, where the plant is a seed (page 2631, column 1, ¶s one and two).

Accordingly Robleto et. al. anticipate the claimed invention.

10. Claims 1, 6, 7, 9, 10, 15, 16, 18, and 26 remain rejected under 35 U.S.C. 102(b) as being anticipated by Robleto, et. al. Environmental Microbiology, 1998, Vol 64, No. 7, page 2630-2633, as evidenced by Breil, et. al., J. Bacteriol. 1993, vol. 175, pages 3696-3702 (Applicant's IDS), and Breil et al, NCBI Accession No. L06719, locus RHMTFXA2G, 4 August 1993.

The teachings of Robleto et. al. are discussed above. Robleto does not explicitly teach SEQ ID NO: 1. However, the pT2TFXK plasmid taught by Robleto et. al. inherently comprises SEQ ID NO: 1, given the common gene source, gene length, operon content, and author/inventor Triplett, as evidence by Breil et. al. Breil teaches a bacterial DNA sequence which confers trifolitoxin production (Abstract) which is identical to SEQ ID NO: 1.

Applicant traverses (Response, p. 8) saying primarily that Robleto does not teach or suggest a method of controlling crown gall disease by introducing onto a plant a strain of Rhizobiaceae engineered to express a TFX operon and produce trifolitoxin, and that this novel ideas was only discovered by the inventors.

Applicant's traversal is unpersuasive. Since the prior art teaches the same process steps and starting materials as those claimed, Applicant's arguments re the alleged lack of inherency are unpersuasive given the breadth of the claims. See *Integra Life Sciences I Ltd. v. Merck KGaA*, 50 USPQ2d 1846 (DC SCalif, 1999) which teaches that a reference teaching a process may anticipate claims drawn to a method comprising the same process steps, despite the recitation of a different intended use in the preamble or the later discovery of a particular property of one of the starting

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materials or end products. See also *Ex parte Novitski*, 26 USPQ2d 1389 (Bd. Pat. App. & Inter. 1993), which teaches that a reference teaching a claimed process, wherein one of the claimed properties of a product used in the prior art process is inherent but undisclosed by the reference, may be properly applied as art against the claimed process.

Remarks

11. No claims are allowed. Claims 2-4, 8, 12-13, 17, 19, 21, 22 and 24-25 are deemed free of the prior art, given the failure of the prior art to teach or reasonably suggest *Agrobacterium* or *Agrobacterium vitis* F2/5 as bacterial host for trifolitoxin production, or the plant hosts of claims 8 and 17.

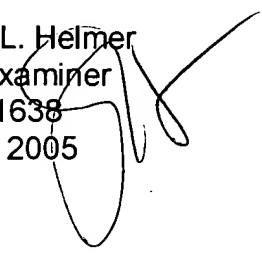
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Georgia L. Helmer whose telephone number is 571-272-0976. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on 571-272-0804. The fax phone number for the organization where this application or proceeding is assigned is ~~703-872-9306~~.

571-273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Georgia L. Helmer
Patent Examiner
Art Unit 1638
June 27, 2005



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